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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/505,356

08/19/2004

Gerald J Julien

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02/06/2009

EXAMINER

WALTERS, JOHN DANIEL

ART UNIT

PAPER NUMBER

3618

MAIL DATE

DELIVERY MODE

02/06/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |   |  |
|------------------------------|--------------------------------------|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/505,356 | <b>Applicant(s)</b><br>JULIEN, GERALD J |  |
|                              | <b>Examiner</b><br>JOHN D. WALTERS   | <b>Art Unit</b><br>3618                 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-12 is/are allowed.
- 6) ☒ Claim(s) 1-4 and 13-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 1 – 4 and 6 – 20 have been examined. Claim 5 has been canceled by Applicant.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 4 and 13 – 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's disclosure in view of Abkowitz et al. (6,318,738) and Julien (WO9729892). Applicant's disclosure states that the following physical structures are "...conventional and are well known to those skilled in the art":

- a blade body having an ice contacting bottom edge (Fig. 1, item 30);
- said blade body having a structure for engaging a blade holder (Fig. 2, item 34);
- said bottom edge having opposed corners that are sharpened (Fig. 3);
- said blade holder being connected to a boot (Fig. 1).

Abkowitz discloses titanium composite skate blades comprising:

- a titanium material blade, defined as any of the following: pure titanium, titanium alloys, or titanium matrix composites (column 2, lines 41 – 44).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to combine the old and well known blade structure with the titanium

material of Abkowitz in order to provide improved strength, corrosion resistance, wear resistance and reduced weight (column 1, lines 59 – 62).

Abkowitz does not specifically disclose the use of Type 60 Nitinol, however, Julien discloses a blade comprising:

- an inter-metallic compound of about 60% nickel and about 40% titanium by weight (abstract).

Applicant lists many standard physical properties for “Type 60 Nitinol” within claims 1 – 4 and 13 – 20. Each material selected would provide differing physical properties, as these properties are dependent upon the physical and chemical structure of each individual material. It would have been obvious to one of ordinary skill in the art at the time the instant invention was made to make use of the material of Julien with the old and well known skate blade made from a titanium material, as taught by Abkowitz, in order to provide corrosion resistance, hardness, toughness and flexibility, (page 2 of 17, paragraph 10).

#### ***Allowable Subject Matter***

Claims 6 - 12 are allowed.

#### ***Response to Arguments***

Applicant's arguments filed 12 May 2008 have been fully considered but they are not persuasive.

Applicant states, "Abkowitz does not disclose or suggest the use of 60 Nitinol as a skate blade material, even though it was known at the time of his invention."

Applicant further discusses the properties of Type 60 Nitinol as well as a Declaration under Rule 132 by Susan Buchanan, President of Triumph Sport, Inc., licensee of this application.

As stated in the rejection of 21 May 2007, "The Office appreciates the information provided by Ms. Buchanan, however, Abkowitz specifically and directly states that titanium alloys are appropriate materials for use in skate blades (as noted above, column 2, lines 41 - 44). This direct statement of applicability would lead one of ordinary skill in the art to consider and potentially pursue the use of a titanium alloy, such as one of the various formulations of Nitinol, in the construction of a skate blade. While Applicant further discusses physical properties and economic concerns that may apply to the use of 60 Nitinol, one cannot disregard the direct suggestion by Abkowitz to investigate the use of titanium and titanium alloys in the manufacture of skate blades."

For this reason, the rejection stands.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Buehler et al. (3,174,851) disclose nickel-base alloys;
- Sahatjian (4,909,510) discloses a ports racquet netting;

- Murai (4,952,044) discloses a metallic eyeglass frame and method for making the same;
- Wood (5,776,214) discloses a method for making abrasive grain and abrasive articles;
- Carpenter et al. (6,149,742) disclose a process for conditioning shape memory alloys;
- Johnson et al. (6,266,914) disclose spinner-type fishing lures and wire and cable fishing leaders.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN D. WALTERS whose telephone number is

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(571)272-8269. The examiner can normally be reached on Monday - Friday, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Ellis can be reached on (571) 272-6914. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher P Ellis/  
Supervisory Patent Examiner, Art Unit 3618

John D. Walters  
Examiner  
Art Unit 3618

/J. D. W./  
Examiner, Art Unit 3618